PATENT
Attorney Docket No. 944-001.103-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: **Aksu et al.**	:	Confirmation No.: **5213**
Serial No.: **10/779,318**	:	Examiner: **Alina Boutah**
Filed: **February 13, 2004**	:	Art Unit: **2143**

For: **METHOD FOR SIGNALING STREAMING QUALITY ADAPTATION AND CONTROL MECHANISM IN MULTIMEDIA STREAMING**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer of November 26, 2007, and in furtherance of the Appeal Brief filed October 16, 2007:

REMARKS

Appellant responds to the Examiner's Answer of November 26, 2007 by reiterating the arguments set forth in the Appeal Brief filed October 16, 2007, and addresses the points raised by the Examiner as follows.

The Examiner asserts in Section 10 of the Examiner's Answer that the teaching-suggestion-motivation (TSM) test is one of a number of valid rationales that can be used to determine obviousness, but it is not the only rational that may be relied upon to support a conclusion of obviousness. However, the Supreme Court has stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KRS Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007). Furthermore, the Court has also stated that there "is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis." *Id.* In fact, in the following paragraph of the Examiner's Answer the Office appears to rely upon the TSM test when responding to applicant's arguments. The Office specifically states that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some *teaching, suggestion, or motivation* to do so." (emphasis added). Therefore, while the Office states that other rationales may be relied upon to support a conclusion of obviousness, the Office is specifically relying upon the TSM test to support its obviousness determination. Accordingly, in the absence of any other assertions by the Office that another rationale can be used to support a conclusion of obviousness, the appellant will specifically address the Office's obviousness conclusion based on the TSM test.

The Office asserts that page 1, lines 31-34 of applicant's specification teaches adaptation of the data delivery process, and that the motivation to modify *Riddle* can be derived from this section. However, page 1, lines 31-34 specifically states, "in order for a service to be successful from the data delivery and playback performance point of view, the *data delivery control* mechanisms in the service must also be well defined. Such mechanisms are used to *adapt* the data delivery process in order to cause the changes of behavior in the underlying network characteristics." (emphasis in original). Therefore, this section of the specification merely points out what is <u>needed</u> in the art, and does not state that information indicative of the attributes defining the adaptation mechanisms or capabilities regarding data delivery process supported by a client are provided, as recited in claim 1, but instead that the mechanisms <u>must</u> be

well-defined. This assertion is further supported by page 2, lines 24-27 of the specification, which states, "there is a certain need for a *capability identification mechanism* to identify the supported adaptation mechanisms or capabilities and an *adaptation capability signaling and negotiation mechanism* for the server and client to agree on the usage of a particular set of adaptation mechanisms or capabilities defined within the service context." (emphasis in original). Therefore, the specification merely points out what the present invention, as recited in the claims, attempts to provide. However, pointing out the deficiencies in the teachings of the prior art is not the equivalent of describing what is known in the art.

In fact, the Office acknowledges that its assertion is derived directly from Applicant's own disclosure, and in the following paragraph of the Examiner's Answer states that as long as any judgment on obviousness takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from applicant's disclosure any conclusion on obviousness is not based on improper hindsight reasoning. However, the knowledge that the Office takes only from applicant's disclosure is the need for a capability identified mechanism, as recited in claim 1 for example. Therefore, without applicant's specification specifically pointing out the need for such a mechanism, there would be no motivation to make the modifications to the teachings of *Riddle* asserted by the Office as obvious.

For at least the foregoing reasons, applicant respectfully disagrees with the assertions raised by the Office in the Examiner's Answer, and respectfully submits that independent claim 1, as well as the other independent claims and those claims depending there from, are not disclosed or suggested by *Riddle* in view of the AAPA.

Conclusion

In view of the above, it is respectfully submitted that the rejection of claims 1-18 are in error and must be reversed. Such reversal is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Date: 28 January 2008

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